

Remarks

Favorable reconsideration of this application in the light of the amendments and the following discussion is respectfully requested. Claims 1, 2, 3, 9, 17 and 22 have been amended. Claims 1-3, and 5-28 are pending. Claims 4 and 29-40 have been withdrawn.

Election/Restriction

The Examiner stated that the application contains claims directed to the following patentably distinct species:

Group I claims 1-3 and 5-28,

Group II claims 4 and 29-40.

The Examiner asserted that the species are independent or distinct because Group I and II are mutually exclusive. According to the Examiner, Group I places a bonding composition between a fluoropolymer and a substrate and Group II requires mixing the fluoropolymer with the bonding composition and contacting the mixture to the substrate.

The Examiner noted that applicants' representative on December 7, 2006 made a provisional election with traverse to prosecute the invention of Group I, claims 1-3 and 5-28. Affirmation of this election must be made by applicant in replying to the Office action.

Applicants affirm the election of Group I, claims 1-3 and 5-28. Applicants respectfully traverse the restriction requirement and election requirement. M.P.E.P. § 803 requires that the two conditions be met for a proper requirement for restriction between patentably distinct inventions. First, the inventions must be independent or distinct as claimed. Second, there must also be serious burden on the Examiner if restriction is not required (see M.P.E.P. §803.02; §806.04 (a)-(j); §808.01 (a); and §808.02).

Applicants submit the restriction between groups I and II is improper because the claims would not impose a serious burden on the Examiner if both groups were prosecuted under the same application. In support, applicants respectfully point out that both groups I and II represent bonding compositions involving fluoropolymers to other substrates. Reconsideration of the restriction is respectfully requested.

Rejection under 35 USC § 102

Claims 1,3,5,6,9, 11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Baum et al. [U.S. Pat. No. 3,558,345] for the reasons set forth in paragraph 4 of the Office Action.

Applicants' Response to the Rejection under 35 USC § 102

Applicants submit that the amended claim 1 is patentable over Baum. The amended claim states the fluoropolymer used in the method is a partially fluorinated thermoplastic polymer. Support for the amendment is found in the specification on page 5, line 32 through page 6 line 15.

Baum discloses a method of bonding a perfluorinated polymer to a glass substrate using an amino-functional silane coupling agent. The reference fails to teach, suggest or disclose the use of a partially fluorinated, thermoplastic polymer. None of the polymers disclosed in Baum are partially fluorinated.

According to the MPEP, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631) (emphasis added). Since the reference fails to describe a partially fluorinated, thermoplastic polymer, such reference would not anticipate the present invention. Claims 3, 5, 6, 9, 11 and 16 each depend from claim 1 and are patentable over Baum at least on that basis. Accordingly, the rejection of claims under 35 U.S.C. 102 should be withdrawn.

Rejection Under 35 USC § 103

Claims 1-3 and 5-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grootaert et al. [U.S. Pat. No. 5,882,461] in view of Fukushi [U.S. Pat. No. 5,658,671] for the reasons set forth in paragraph 6 of the Office Action.

Applicants' Response to the Rejection Under 35 USC § 103

Applicants assert that the amended claims are patentable over Grootaert et al. in view of Fukushima.

Grootaert discloses a method of bonding fluoropolymer material to a substrate using a bonding composition. The bonding composition is an amino-substituted organo silane composition. Grootaert discloses bonding the substrates together using methods known in the art. The Examiner has acknowledged that Grootaert does not disclose heating the combined substrates to form a bonded article.

Fukushi teaches a method of bonding a fluoroelastomer to a substrate using a silane coupling agent. Fukushi fails to teach, suggest or disclose a mechanism for bonding a partially fluorinated thermoplastic polymer to a substrate by using an amino-substituted organosilane. Fukushi only discloses fluoroelastomers as potential fluoropolymers.

According to the MPEP, "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP 2143.

Thus applicants submit that there is no motivation to combine the references and achieve the invention as set forth in the amended claims. Neither Grootaert nor Fukushima suggest the specific combination recited in the amended claims. Claims 2-3, 5-16, and 18-28 each depend from either claim 1 or claim 17 and are patentable over Baum at least on that basis. Accordingly, the rejection of claims 1-3 and 5-28 under 35 U.S.C. 102 should be withdrawn.

Applicants acknowledge that the prior art made of record and not relied upon is considered pertinent to applicant's disclosure. However, the references noted by the Examiner in the Office Action do not provide a basis for rejecting the claims of record.

Conclusion

In view of the foregoing remarks, favorable reconsideration of the present application and the passing of this case to issue with all claims allowed is courteously solicited.

Should the Examiner wish to discuss any aspect of this application, applicants' attorney suggests a telephone interview in order to expedite the prosecution of the application.

Respectfully submitted,

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Date

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